

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1 through 14 remain pending in this application. Claims 1 and 14 have been amended.

Claims 1-8 and 13 have been rejected under 35 USC 102(b) as being anticipated by Stich et al. US patent 5,760,381. Reconsideration and withdraw of the rejection is again earnestly solicited.

Stich et al. relate to a point of sale card package and not to a greeting card as suggested by the Examiner and required by the claims. The terms “greeting”, “holiday”, “occasion” or “gift” are simply not found anywhere within the specification of Stich et al. and Stich et al. do not anticipate the claims of the present invention.

Point of sale products and greeting cards do not compete with one another and are purchased for entirely different reasons. Greeting cards are given specifically for special occasions such as holidays, anniversaries, congratulatory events, etc. Point of sale packages are purchased regardless of an event or special occasion and are unchanging or “generic” so as to prolong the useable shelf life of the product. Greeting cards are intended to be personalized to add a note, comment or sentiment that is specific to the recipient prior to giving. Point of sale products are simply consumed with little or no thought about the user or the reason for the purchase and provide a commodity for everyday life, one that is not used to remember any particular event.

Greeting cards, without any supplemental items, such as plastic cards or inserts, normally cost several dollars apiece. They are printed on high quality or glossy stock,

and may contain embossing, high quality graphics or images, special printing, textural attributes, pop outs and the like. Thus, greeting cards themselves are considered gifts due to the value of the card.

Point of sale products, such as Stich et al., are produced in as an economical fashion as is possible. The manufacturer wants to deliver the commodity to the consumers in an efficient and economical manner as is possible so as to maximize ones profits. The cost of the packaging is often the most significant cost in delivering products and increasing the cost of the packaging decreases the possible profits that a manufacturer may reap. Thus, point of sale products are produced with inexpensive stock, limited colors and graphics.

In addition, Stich et al. simply cannot function as a greeting card. As is made clear by the abstract of Stich et al. “the [debit] card may be activated at the point of purchase without the necessity of in any way opening up the attractive packaging, or moving any portion of the packaging out of the way...” (emphasis added). The purpose of the Stich et al. package is to provide a secure arrangement such that the “majority of the card is typically sandwiched between the first and second panels...” Stich et al. are replete with references that the panels that hold the card are affixed to one another, see for example column 3, lines 8-9, column 4, lines 46-48 and lines 55-63, column 5, lines 22-24 and column 6, lines 22-25. See also the adhesive sealing patterns depicted in FIGURES 4, 10, 11 and 12 which illustrate the use of adhesive to seal the panels of the card package closed.

One does not seal the panels of a greeting card together; rather the giver of the greeting card desires the recipient to open the card to see the personalized sentiment expressed internally of the card. If one were to seal the panels of the greeting card together as required by Stich et al. such an action would then necessitate that the recipient

remove tear off strips or otherwise tear open, such as disclosed in Stich et al., which would then likely create a shabby appearance for the card detracting from the expression of sentiment. The Stich et al. construction is thus more analogous to a non-descript, or “generic” postcard and not a greeting card due to the sealed nature of the product.

Applicant believes that it is unlikely, that someone giving, as well as receiving a remembrance card for an anniversary, birthday, congratulatory event or the like would want to tear away part of the card to gain access to the interior. Once the card is removed from the Stich et al package, the package serves no further use and is discarded as are virtually all point of sale card packages. Greeting cards on the other hand are retained as a remembrance item and may be used repeatedly to recall a particular time, place or event that has special meaning to the recipient. A point of sale package, once used is garbage.

In order for Stich et al. to function as suggested by the Examiner, such a construction would require the discarding of the adhesive strips or other sealing means that are used to affix or seal the panels of the Stich et al. construction to one to another. “In its consideration of the prior art, however, the district court erred --- in disregarding disclosure in the references that diverge from and teach away from the invention at hand. In re W.L. Core & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983). “It is impermissible to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggest to one skilled in the art” Bausch & Lomb, Inc. v. Barnes-Hind Hydorcurve, Inc., 796 F.2d 443, 448 (Fed. Cir. 1986).

The Examiner has also ignored the limitation contained in claim 1 that the greeting card contains personalized information, which has now been further emphasized in the claims. A point of sale package contains no such indicia and as the Examiner has correctly pointed out on page 4 of the Official Action, paragraph 12, “the indicia of Stich

et al. is generic...” (emphasis added). Personalized indicia, as is readily understood by those skilled in the art, relates to information that is unique to the recipient, not information that is “generic” to an event. Point of sale packages may be purchased by any member of the consuming public and a consumer simply picks a package at random from the retail display. As such, personalization cannot occur. Thus, Stich et al. do not anticipate claims 1-8 and 13 as there is simply no disclosure of a greeting card or the use of personalized information.

In addition, Stich et al. do not disclose that a message is concealed by the gift card. There is no support for the Examiner’s statement that “Figure 12 (among others) the graphics/indicia will be under the gift card when the panels are folded, thereby concealing a message on the panel.” In respect of Figure 12 and Figure 11, the graphics indicia are concealed by the third panel and not by the card as is clear from a reading of the specification. In Figure 8, the graphics are on the face of the card and are only visible due to the inclusion of a transparent patch. But again, there is no use of the card to conceal a personalized message. Thus, there is no disclosure in Stich et al. that the card conceals anything let alone a message. In any event, the applicant has amended claim 1 to include that the concealed message is a “personalized” message, which for the reasons set forth above would not be found in a point of sale retail package as any member of the public could pick up the package for purchase.

As each and every limitation recited in the claims is not found in Stich et al. as required by section 102, applicant respectfully requests withdraw of the rejection and allowance of the claims at issue.

Objective, supporting evidence is required to support a rejection. The rejection in this case suffers from the “it is so simple that it must have been obvious” hindsight syndrome. The CAFC has recognized the tendency for such hindsight rejections and has

often reiterated that they cannot stand. As stated by the Federal Circuit in reversing the rejection of applicant's claims in the "pumpkin trash bag" case, In Re Dembiczak et al., 50 USPQ2d 1614, 1617 (CAFC 1999).

"Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (citing cases). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references...

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight."

The Federal Circuit explicitly ruled out any probative effect of any rejection that points out how the references could be combined with a general reliance on the "skill of the art," as here, and held:

"Yet this reference by reference, limitation by limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention (citing cases). Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand."

Claims 9-11 have been rejected by the Examiner under 35 USC 103 as being unpatentable over Stich et al. Reconsideration and withdraw of the rejection is again earnestly solicited.

As indicated previously, Stich et al. is directed to a point of sale package, one that is produced in efficient quantities so as to achieve the maximum economy in order to reap the most profit possible. Transponders and transmitters while available, significantly increase the costs of any product with which they are included. As such, a manufacturer intending to produce a package as economically as possible would likely not resort to use of such components.

“As this Court has stated, ‘virtually all [inventions]’ are combinations of old elements.” (citations omitted) (‘Most, if not all, inventions are combinations and mostly of old elements.’) Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Further, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as the blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’ (citation omitted) In re Rouffet, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Radio frequency technology is applied only to high value items due to the cost associated not only with the transmitters or transponders but also with the systems needed to read and detect the presence of such components. Thus, a point of sale package such as Stich et al., prior to activation of the card at the check out is only worth a few cents, one to three cents for the package and three to five cents for the plastic card, and is simply not worth the cost of adding security to the package. Adding a transponder and/or transmitter would increase the cost of the package 10 or more fold. There is simply no need to add such security measures to a package nor would one skilled in the art recognize the need or value of adding such expensive components to the point of sale package of Stich et al.

Stich et al. do not teach a greeting card with a bar code included for activating the enclosed gift. Stich et al. do not suggest a greeting card let alone activation devices for use with a greeting card.

As for the Examiner's comments that it would only be a matter of "obvious matter of design choice" we offer Ex parte Markowitz, 143 USPQ 303, 304, wherein the Court held:

"While these changes may be relatively simple once the advantage for making them has been made clear, by appellant's disclosure there is no suggestion in Ricketts et al that this should be done. Hence, the examiner's contention that Ricketts et al present a matter of choice or design in the selection of driving currents to the person of ordinary skill is true only after appellant's disclosure has shown the way."

Applicant respectfully requests that the rejection of the claims under section 103 be withdrawn as there is not teaching or desirability to one skilled in the art to make the change as suggested by the Examiner.

The Examiner has rejected claim 12 under 35 USC 103(a) as being unpatentable over Stich et al. in view of Smith et al. Reconsideration and withdraw of the rejection is again earnestly solicited.

Stich et al. do not teach or suggest a greeting card, let alone a greeting card with a window as suggested by the Examiner. Smith et al. does not remedy the deficiencies of Stich et al. Smith et al. is also not directed to a greeting card but rather is simply another point of sale type product. As with Stich et al. the specification of Smith et al. is completely devoid of a single reference to the terms "greeting", "holiday", "occasion" or "gift."

Claim 14 has been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Stich et al. in view of Fonesca, US 5,629,977. Reconsideration and withdraw of the rejection is again earnestly solicited.

Point of sale packages such as Stich et al. are not placed in envelopes as suggested by the Examiner as to do so increases the cost and in addition would eliminate the need to place "attractive" graphics on the exterior of the packing component. In order to maintain manufacturing efficiencies, one with skill in the art, in utilizing the construction suggested by the Examiner would then simply just place the loose card in an envelope and avoid the cost and time associated with manufacturing the packaging piece. Such a structure would provide an inexpensive point of sale delivery piece which is the principal driving focus of those delivering point of sale packages. Thus, in applicant's view the combination does not arise as there is simply no motivation to make the suggested modification.

In order for a *prima facie* case of obviousness to exist, the prior art must teach the desirability of a modification or combination of the references. Any suggestion or incentive to modify a reference must be derived from teachings of the prior art; it cannot be merely a subjective ex post facto desire to combine the pieces or features to construct a rejection. Thus, the Court specifically held that it was improper to rely on a general teaching in the second reference as a basis for modifying the primary reference. The Court explicated the rational for precluding such subjective hindsight reconstruction of the art in terms which clearly preclude propriety of the Examiner's rejection in this

application. See In re Fritch, 23 USPQ 2d 1780, 1783, 1784 (Fed. Cir. 1992), wherein the Court held:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious ‘modification’ of the prior art. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the examiner and endorsed by the Board.”

Applicant’s invention is not technologically difficult and the elements that the applicant has assembled to produce the present invention are also not complex. Thus while applicant’s invention seems simple after the fact, the invention still represents an incremental improvement in the art. In re Meng, 181 USPQ 94, 97 (CCPA 1974) wherein the Court held:

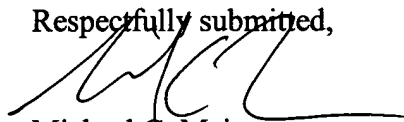
"Of course the invention seems simple, after the fact. But simplicity, particularly in an old and crowded are, may argue for rather than against patentability. In re Sporck, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). Progress in the crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage. In re Hummer, 44 CCPA 814, 241 F.2d 742, 113 USPQ 66 (1957). The Constitution envisages and seeks progress in the "useful arts," not just in those more esoteric or scientific."

This amendment and response is being filed within the shortened statutory period and within TWO MONTHS from the mailing date of the Official Action.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

No fees are believed due in connection with this Amendment and response.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. C. Maier', written over the words 'Respectfully submitted,'.

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